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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,423	01/30/2004	Thomas Thoroe Scherb	VOI0290.US	6960

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EXAMINER	
FORTUNA, JOSE A	
ART UNIT	**PAPER NUMBER**
1731	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/768,423	SCHERB ET AL.	
	Examiner	Art Unit	
	José A. Fortuna	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-63* is/are pending in the application.

4a) Of the above claim(s) *20-44* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-19 and 45-63* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 January 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/05;8/04;5/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Claims 20-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in the reply filed on January 19, 2007.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-19 and 45-63 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 15-22 and 59-64 of copending Application No. 10/768,550. Although the conflicting claims are not identical, they

are not patentably distinct from each other because the scope of the claims overlaps. Note that the copending application is broader than the current application. Note also that claim 10 of the copending application broadly reads in the passing of the air through the fabrics and the web of the independent claims of the current application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

5. Claims 18 and 62 are objected to because of the following informalities: claims 18 and 62 include acronyms, (HPTDA), that should be defined, i.e., what they stand for, at least in the first usage. Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 11-19, 45-47 and 55-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Thoroe-Scherb et al., DE 10129613 A1, (corresponding US Patent Publication Number 2004/0237210 A1, has been used as the translation).

Regarding claims 1 and 45, Thoroe-Scherb et al. teach a method of dewatering a paper web by passing said web between a first, structured fabric (**14**) and a second fabric (**36**) and then passing air through the first fabric, the web and the second fabric, see figures 3-5, [0010]; [0079]-[0084]. Regarding claims 11-19 and 55-63, Thoroe-Scherb et al. teach

that passing step is a negative air pressure, i.e., a vacuum/suction roll (**38**), [0079]-[0080] or a positive air pressure, see figure 5 and [0091]; that the vacuum is greater than 0.1 bar, preferably greater than 0.2 Bar, see [0048], (note that the sign is positive, because it refers to a vacuum); Thoroe-Scherb et al. teach the use of an extended nip press in which the other side of the imprinting fabric is contacted with a extended nip press belt and also teach the passing of air, i.e., through a vacuum roll (**30**), through the extended nip belt, see figure 3 and [0085], and teach that the web is pressed onto a Yankee Drier, where it is also transferred to, see figures.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 11, 18-19, 45-47, 55 and 62-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Morton, US Patent No. 4,102,737 or Sanford et al., US Patent No. 3,301,746.

Both, Morton and Sanford et al., teach a method of dewatering a web in which the web is sandwiched between a forming wire and an imprinting fabric and then air is passed through the fabric/web system, see figures 1-2 of Sanford et al., (cf., forming fabric **11**, imprinting fabric **20**, web **13** sandwiched between the fabrics and air/vacuum systems **18/19** passing a fluid, air, through the sandwiched system, (note that Sanford et al. teach that instead of hot steam, air or other fluids can be used, see paragraph bridging columns 5 and 6)): figure 1 of Morton, (cf., forming fabric (**3**), imprinting Fabric (**4**), sandwiching a web (**2**) and passing a compressible fluid through air/vacuum system (**13**)/(**14**), see also column 3, line 20 through column 4, line 16. Note that both references teach the transferring of the web to a Yankee drier.

9. Claims 1-3, 11, 18-19, 45-47, 55 and 62-63 are rejected under 35 U.S.C. 102(b) as being anticipated by Hermans et al., US Patent No. 6,454,904.

Hermans et al. teach a method of dewatering a web in which the web is sandwiched between a forming wire and an imprinting fabric and then air is passed through the fabric/web system using an air press, see figures 1-3 and column 10, lines 10-62.

Hermans et al. teach that the web after been air presses is transferred to a Yankee drier , see figures.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

13. Claims 4-10 and 48-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thoroe-Scherb et al., cited above, as evidenced by Watanabe, US Patent No. 6,716,318 or Beck, US Patent No. 6,616,812.

Thoroe-Scherb et al. teach dewatering fabrics that seem to be the same as the ones claimed. However, they are silent as to the claimed properties of the fabric. Yet the claimed fabrics are well known dewatering fabrics, see for example Watanabe and Beck just to mention a couple. Note that both beck and Watanabe teach dewatering fabrics, having the limitations of the claims. Therefore, using the dewatering fabrics as claimed would have been obvious to one of ordinary skill in the art, since its use is conventional in the art. Also it has been held that "[W]here two equivalents are interchangeable for their desired function, substitution would have been obvious and thus, express suggestion of desirability of the substitution of one for the other is unnecessary." In re Fout 675 F. 2d 297, 213 USPQ 532 (CCPA 1982); In re Siebentritt, 372 F.2d 566, 152 USPQ 618 (CCPA 1967).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure in the art of "Method for dewatering a paper web."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to José A. Fortuna whose telephone number is 571-272-1188. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

José A Fortuna
Primary Examiner
Art Unit 1731

JAF